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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,019	10/20/2000	Shinichi Baba	1204-US	7461

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EXAMINER

KADING, JOSHUA A

ART UNIT

PAPER NUMBER

2661

DATE MAILED: 07/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/693,019

Applicant(s)

BABA ET AL.

Examiner

Joshua Kading

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-5, 7-10 and 12-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-5, 7-10, and 12-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

5       The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-4, 8-10, and 12-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10

Regarding claim 2, lines 9-12; claim 8, lines 11-14; and claim 13, lines 9-12 applicant discloses creating a tunnel between two network environments using a SIP INFO method. It is unclear from the claim language or specification what constitutes a SIP INFO method. Page 27, lines 5-13 applicant describes  
15       what a SIP INFO method does but fails to describe using a SIP INFO method to create a tunnel between two network environments. What are the method steps? Further, since applicant has decided to be his own lexicographer, he must clearly define what a SIP INFO method is, not merely what it does. By only disclosing what the method does, applicant has not distinctly disclosed the invention and it  
20       is therefore vague and indefinite.

Regarding claim 3, lines 2 and 3 applicant discloses a "SIP\_EYE Agent". What is a "SIP\_EYE Agent"? Page 10, lines 19-21 is the first mention of a "SIP\_EYE Agent" but it does not clearly and distinctly define what an agent is. Is

it an apparatus? Or is it a human as maybe suggested by figure 3, element 300 showing a human eye?

Applicant should also be advised that if the "SIP\_EYE Agent" is not a computer type readable medium, "a record of each of said TCP connections" cannot be stored on it. Thus making "a record" non-statutory subject matter. See MPEP 2106.IV(B1).

Regarding claim 4, lines 4-5; claim 9, lines 6-7; and claim 14, lines 5-6 state "adding a registration or hand-off option to a SIP REGISTER method".

10 What does "adding a registration or hand-off option" mean? Is it an additional step in the method? Or is it an additional field in the SIP REGISTER message? Further, the SIP REGISTER method is not defined in the specification. What are the steps of the SIP REGISTER method? As with the SIP INFO method, if applicant is going to be his own lexicographer, he must define his terms in a way that allows one with ordinary skill in the art to determine and understand what the term means and how it is used.

Claims 5, 10, and 15 are also rejected for the same reasons as their parent claims 4, 9, and 14.

20 Claim 13, line 1 discloses "A system...", however, line 4-5 then claims "said method comprising". It is unclear which applicant regards as his invention, i.e. is it a system or a method?

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

5       Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

      Claims 12-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 12, 13, and 14 (and thus depending claim 15) disclose "a processor programmed to". Merriam-  
10   Webster's dictionary defines processor as follows

*the part of the computer system that operates on data...*

Since a processor manipulates or processes data, it does not store data.

Therefore, a processor is not a computer readable medium (as deemed necessary for statutory subject matter in the computer related arts, MPEP  
15   2106.IV(B1)) and thus cannot store a program.

***Claim Rejections - 35 USC § 103***

      The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

20

      Claims 7 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liao ("Mobile Internet telephony protocol: an application layer protocol for mobile Internet telephony services", 1999 IEEE International Conference) in view of La Porta (U.S. Patent 6,434,134 B1).

25

In regard to claims 7, and 12, Liao discloses a method and a system "...for providing mobility support from a first SIP-compliant network environment to a second SIP-compliant network environment, comprising:

5 assigning a personal identifier to a mobile user (page 341, col. 2, paragraph 3, lines 1-12 where the "user@home\_host" is a personal identifier of the mobile user);

associating said personal identifier to a mobile station (page 341, col. 2, paragraph 3, lines 1-12 where the "user@home\_host" is a personal identifier of the mobile user)..."

10 However, Liao lacks "...associating a first temporary IP address from said first environment with said personal identifier; receiving packets of data at said mobile station from a corresponding host wherein each of said packets of data further comprises a source IP address and a destination IP address, said destination address being said first temporary IP address and said source IP  
15 address being said IP address associated with said corresponding host; monitoring said mobile station to sense movement of said mobile station from said first environment to said second environment; associating a second temporary IP address from said second environment with said personal identifier; forwarding to said second temporary IP address packets of data having said first  
20 temporary IP address as said destination address; sending said second temporary IP address to said source IP address; and discontinuing forwarding of packets of data having said first temporary IP address as said destination address to said second temporary IP address."

La Porta however, discloses "... associating a first temporary IP address from said first environment with said personal identifier (figure 3, element 170 where a "HA" is a "home address" as defined in col. 9, lines 57-59; the "address" refers to an IP address as is mentioned throughout the reference; and the "HA" is temporary as it is only assigned to the device while it is in the home domain, if it were to move out of the home domain a new address must be assigned);

receiving packets of data at said mobile station from a corresponding host wherein each of said packets of data further comprises a source IP address and a destination IP address, said destination address being said first temporary IP address and said source IP address being said IP address associated with said corresponding host (figure 7, elements 314 and 316 although element 318 is defined as a destination address, element 314 is also a destination address, it is the destination address of the mobile station; the refresh message is a packet of data);

monitoring said mobile station to sense movement of said mobile station from said first environment to said second environment (figure 3, element 184);

associating a second temporary IP address from said second environment with said personal identifier (figure 3, elements 176 and 180 where the "COA" is a "care of address" or second temporary IP address assigned to the mobile and associated with the personal identifier);

forwarding to said second temporary IP address packets of data having said first temporary IP address as said destination address (figure 3, element 182);

5 sending said second temporary IP address to said source IP address (figure 3, element 182 where the tunneling of packets, as in figure 14, to the mobile station means that the secondary IP address must be known to the source IP address so the source IP address can forward the packets to the mobile station);

and discontinuing forwarding of packets of data having said first temporary IP address as said destination address to said second temporary IP address (figure 3, elements 214 and 216)."

10 It should also be noted that both Liao and La Porta lack a "computer-readable medium having computer-executable instructions for performing" the method and "a processor" for also performing the method. However, it would have been obvious to one with ordinary skill in the art at the time of invention to have the "computer-executable instructions" or "processor" perform the method because this is the most efficient and feasible way of executing the method.

15 It would have been obvious to one with ordinary skill in the art at the time of invention to include the first and second temporary IP addresses, the receiving of packets, the monitoring of the mobile station, and forwarding of packets with the mobile personal identifier for the purpose of allowing a person to identify the mobile station at all times. The motivation being to have a unique personal

20 identifier for each mobile station to allow for distinctness between the other mobile stations.

### ***Response to Arguments***



The 35 U.S.C. 112 second paragraph rejections for claims 2, 8, and 13 have been withdrawn in light of applicant's amendments. However, claims 2, 8, and 13 have again been rejected under 35 U.S.C. 112 second paragraph as described above.

5

Applicant's arguments filed 28 April 2004 have been fully considered but they are not persuasive.

Applicant argues that Liao does not assign a unique identifier to the actual  
10 user, rather Liao assigns a unique identifier to the user's mobile station and thus does not read on applicant's invention. The examiner respectfully disagrees. Although Liao may not specifically mention if the unique identifier is assigned to the user or to the user's mobile, that is irrelevant. Even if the identifier was only assigned to the user's mobile station, the identifier still belongs to the user  
15 because the mobile station is not independent of the user. The user uses and operates the mobile station and is therefore also identified by the identifier. For example, if a user's mobile station is identified by the "user@home\_host" as in Liao, the data and messages sent to the mobile station are still intended for the user, not the mobile station (this can also be seen in the identifier of Liao, i.e.  
20 "USER@home\_host").

Applicant argues that the home agent in LaPorta is not used in applicant's invention and therefore LaPorta does not read on applicant's claim. The

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examiner respectfully disagrees. First, as stated in the initial rejection, the "HA" referred to in figure 3, is representative of the "home address", which reads on applicant's "first temporary IP address". The "HA" of figure 3 is not meant to be a home agent. Secondly, applicant argues that his invention does not use a "home agent" and therefore is not rejectable using LaPorta. It is not clear where in the claim language or specification it states there is no "home agent" used? Further, the claims are silent on the use or non-use of a "home agent", therefore the examiner is permitted to read the claims as broadly as possible (see *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)) and in this case LaPorta fully reads on applicant's invention as read by the examiner and explained in the rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua Kading whose telephone number is (703) 305-0342. The examiner can normally be reached on M-F: 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas Olms can be reached on (703) 305-4703. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through

- 5 Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Joshua Kading  
Examiner  
Art Unit 2661

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June 21, 2004



KENNETH VANDERPUYE  
PRIMARY EXAMINER